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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1965

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No. 57

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HAZELTINE RESEARCH, INC. and ROBERT REGIS,  
*Petitioners,*

vs.

DAVID L. LADD, COMMISSIONER OF PATENTS,  
*Respondent.*

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## REPLY BRIEF FOR PETITIONERS

### I. INTRODUCTION

There are two faulty arguments that pervade Respondent's Brief\* and tend seriously to confuse rather than to clarify the single issue before the Court. The first untenable argument is that a copending patent negatives "patentability" of a later filed patent application under all sections of the Patent Act which establish the conditions for patentability. The second erroneous argument is based on the false assumption that at any time the Patent Office or other cognizant tribunal finds it necessary to supply a deficiency in the disclosure of a copending patent by reference to the prior art, e.g., to prior issued patents, the deficiency thus supplied is inevitably "insignificant".

Further, Respondent's Brief includes a number of statements and arguments which are believed to be erroneous or misleading. These will be taken up in order after discussion of the two foregoing main points.

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\* For brevity, the Brief for the Commissioner of Patents, Respondent, is cited as BR

## II. COPENDING PATENTS NEGATIVE PATENTABILITY OF LATER FILED PATENT APPLICATIONS ONLY UNDER SECTION 102(e) OF THE PATENT ACT.

The "conditions for patentability", expressed negatively, are set forth in the seven subsections of Section 102 and in Section 103 of the Patent Act (Title 35, U.S.C., Sections 102, 103; BP, pp. 2-3\*). Under Section 102(e), "patentability" of an invention claimed in a patent application is negated by an earlier-filed copending patent describing "the invention", the copending patent showing that the later applicant was not the first inventor. Under Section 103, "patentability" of an invention claimed in a patent application is negated by showing that such invention represents but an obvious departure from the prior art. These are the two premises of Respondent's false syllogism. Other subsections of Section 102 set forth other bars to patentability of inventions.

From the foregoing two correct premises, Respondent jumps to the false conclusion that copending patents are "relevant" to "patentability" *generally* under the Patent Act and *specifically* under Section 103. It has been shown previously (BP, pp. 7-20) that copending patents are not within the term "prior art" as that term is used in Section 103.

Respondent repeatedly cites decisions or authorities enunciating the *specific* principle that copending patents may be employed to negative "patentability" under Section 102(e) (or under the principle of *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, codified by Section 102(e)) but then erroneously relies upon these authorities for the proposition that such copending patents can be utilized to negative "patentability" *generally* under all sections of the Patent Act dealing with "con-

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\* For brevity, the Brief for Petitioners is cited herein as BP .

ditions for patentability." A few examples will illustrate this over-generalization. Thus Respondent argues:

"The Patent Office and the courts below invoked the principle—established by this Court's 1926 decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390—that, for the purpose of judging the *patentability* [emphasis added] of a subsequent invention, a copending and ultimately issued United States patent *dates from the time when the application was filed* [emphasis Respondent's] rather than from the date when the patent is ultimately issued. \* \* \*" (BR, pp. 6-7)

But it is recognized that the *Alexander Milburn* case decided *only* that such a copending patent may be used to show that the inventor of the application in issue was not the first inventor, now covered by Section 102(e).

Again, Respondent argues:

"\* \* \* The principle of the *Milburn* case, originally a judicial gloss upon the patent statute, has since been explicitly codified in Section 102(e) of the 1952 Patent Act (35 U.S.C. 102(e)), providing that a patent shall not issue if 'the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.' The 1952 Act [impliedly including all sections and subsections of the Patent Act establishing conditions for patentability] thus treats copending patents as equivalent to previously issued patents, which are relevant references under Section 102(a) (35 U.S.C. 102(a))." (BR, p. 7)

The final sentence of the foregoing excerpt from Respondent's Brief is clearly a *non sequitur*.\*

\* This false argument is reiterated elsewhere throughout Respondent's Brief:

"\* \* \* it was \* \* \* entirely clear before the 1952 Act that disclosures of prior inventions in copending patents \* \* \* were competent, under the rule of this Court's *Milburn* decision, to negate *patentability* for lack of a significant advance in the art under *Hotchkiss v. Greenwood*. \* \* \*" (pp. 8-9; emphasis added)

"\* \* \* Indeed in all but one of the cases upon which petitioners rely, the copending patents involved were, in fact, actually used to judge *patentability* despite the court's statements that they were not part of the 'prior art.' \* \* \*" (pp. 18-19; emphasis added)

"\* \* \* *In re Spencer*, 47 F.2d 806 (C.C.P.A.) \* \* \* does not [emphasis Respondent's] contain the general statement that copending patents are not part of the prior art, and \* \* \*, although it rejects a reference as relevant in judging *patentability*, [emphasis added] apparently does so on the ground that the reference was filed after, rather than before, the patent in issue. \* \* \*" (p. 19)

"Hence it is clear that statements in the opinions cited by petitioners, that copending patents are not 'prior art,' are not directed toward the use of copending patents as references *relevant to patentability*. \* \* \*" (p. 20, emphasis added)

"\* \* \* copending references are not *prior art* since they are not made public until after the patent in issue; they are nevertheless *relevant art* \* \* \*." (p. 20; emphasis Respondent's)

"\* \* \* prior to the Patent Act of 1952, it was clear beyond doubt that copending patents were *relevant* references, as of their filing dates, in determining the *patentability* of subsequent inventions \* \* \*." (p. 21; emphasis added)

"\* \* \* Although some confusion existed as to whether the then non-statutory term, 'prior art,' was properly used in referring to such *relevant* copending patents \* \* \* there was no doubt of their *relevance* \* \* \*." (p. 21; emphasis added)

"\* \* \* Congress also codified, in Section 102(e), the rule of *Alexander Milburn Co. v. Davis-Bournonville Co.*, *supra*, under which copending patents had uniformly been used as *relevant* references in cases falling under the *Hotchkiss* rule. \* \* \*" (p. 22; emphasis added) [*Hotchkiss v. Greenwood* (1850) 11 How. 248, did not involve a consideration of copending patents at all; it stands only for the principle that an invention is not patentable if it was obvious in the light of admitted prior art, now codified in Section 103.]

"\* \* \* As part of Section 102, subsection (e) is, indeed, one of a group of references made specifically *relevant* in judging *patentability*. \* \* \*." (p. 22; emphasis added)

Thus Respondent has introduced serious confusion into the case by repeated references to authorities applying copending patents under Subsection 102(e) of the Patent Act but arguing that such holdings extend the applicability of copending patents to *all* sections of the Patent Act dealing with conditions for patentability.

### III. RESPONDENT'S POSITION RESTS ON THE FALSE PREMISE THAT REFERENCES TO THE PRIOR ART TO SUPPLY DEFICIENCIES OF AN INCOMPLETE DISCLOSURE OF A COPENDING PATENT ARE INEVITABLY "INSIGNIFICANT"

Respondent repeatedly and mistakenly states Petitioners' position, asserting it to be that a copending patent cannot be used to negative patentability of an invention which is only an *insignificant* variation of the disclosure of a copending patent. Thus Respondent argues:

"\* \* \* Specifically, petitioners urge that while the *Milburn* rule applies when a copending patent discloses the *exact* [emphasis Respondent's] invention claimed in an application on a subsequent 'invention,' the rule does not apply when the subsequent application contains *some* difference from, or variation upon, the copending patent. This is so, petitioners argue, *even though the difference or variation, as in this case, is an insignificant one* which would not constitute a patentable advance over the copending patent under Section 103." (pp. 7-8; emphasis added)

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"\* \* \* The *John Blue* case reveals nothing in petitioners' favor beyond some continuing confusion regarding terminology; the copending patent there involved was, in fact, used as a relevant reference to judge *patentability*. \* \* \*" (p. 26, emphasis added)

"\* \* \* Notwithstanding the rule requiring the secrecy of patent applications, the Court [in *Alexander Milburn, supra*] held the teachings of the prior copending application *relevant* in testing the *patentability* of the later application. \* \* \*" (p. 28; emphasis added)



Petitioners have not taken, and do not take, any such position. A copending patent will bar the grant of a patent for an invention which represents only an insignificant variation thereover in the same way that a single prior art patent will preclude the grant of a patent on an insignificant variation thereover under Section 102(a), without reference to any additional prior art.

A simple example may serve to illustrate. Assume, *arguendo*, that the Wallace et al. patent (R. 54A) disclosed everything claimed by Regis except for a simple cabinet to house it. Putting anything in a cabinet or a housing is a matter of such common knowledge and such an insignificant variation that no citation of prior art showing the use of a cabinet would be required. As stated in *Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150, 153, any "competent worker in the field \* \* \* would have found the means at hand". Under such an assumption, the invention of the Wallace et al. copending patent and the Regis invention would, in effect, be the *same* invention and, under Section 102(e), Wallace et al. would bar the grant of a patent to Regis.

*But the factual situation of this case is not within the foregoing assumption nor is it within Respondent's above-quoted statement.* The Regis invention is not an insignificant variation of the disclosure of the Wallace et al. patent and neither the Patent Office nor the Courts below ever contended that it was. The Patent Office rejected the Regis claim to a patent solely "as being unpatentable over Wallace et al. in view of Carlson" (R. 20A, 23A, 43A). As pointed out previously (BP, pp. A-2, A-3), the Wallace et al. patent (R. 54A) discloses a shutter for interrupting the flow of microwave energy through a waveguide while the Carlson patent (R. 50A) discloses a piece of laboratory test equipment, called an attenuator, calibrated to indicate the amount of attenuation of a microwave signal passing down a hollow waveguide. There is no indication whatever that



the technical disclosure of the Carlson patent, which the Patent Office proposed to add to that of Wallace et al., is an insignificant one. The presumption is that it is not, for Carlson was granted a patent on it.

Respondent further introduces confusion into the case by reiterating this factual misstatement at several points of its Brief:

"\* \* \* the answer was not always so clear in cases where the copending applications did not claim a patent on *exactly* the same invention, but where the disclosures in the prior copending patent nevertheless would, if considered to be part of the relevant art, affect the patentability of the subsequent patent by showing it to be an *insignificant advance* in the art. \* \* \*" (pp. 10-11; emphasis added)

"\* \* \* In the instant case, Wallace and Carlson did not thus completely describe the Regis invention; they did, however, make claims, in light of which Regis' invention is unpatentable as an *insignificant advance* in the art. \* \* \*" (p. 13; emphasis added)

"\* \* \* Regis is, consequently, unpatentable whether identically disclosed by Wallace and Carlson or *merely an insignificant advance* over those two patents." (p. 14; emphasis added)

#### IV. MISCELLANEOUS COMMENTS

Respondent cites (BR, p. 16) a large number of cases which it asserts supports its position that a copending patent is prior art as of its filing date. The majority of these cases were previously cited by Petitioners (BP, p. A-5). However, it is submitted that the following cases, included by Respondent, do not support this position, or support it only with qualification:

*Industrial Wire Cloth v. United Specialties* (C.A. 6, 1951) 186 F.2d 426

*Permo v. Hudson-Ross* (C.A. 7, 1950) 179 F.2d 386

*Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150

*In re Youker* (CCPA, 1935) 77 F.2d 624

*Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379

*Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345.

In the event the Court is interested in considering the actual holdings in these cases, an analysis of the facts and the ruling of each is included in the Appendix to this Reply Brief. These analyses answer fully Respondent's misinterpretation of the *Western States Machine* decision (BR, pp. 16-18) and the *Old Town Ribbon* decision (BR, p. 19) as well as its criticism of Petitioners' citation of a number of these cases as supporting their position (BR, p. 20).

Respondent's Brief contains a number of inaccurate or misleading statements which require comment. It is believed that the errors can be pointed out most readily by setting out the criticized statements and the comments thereon in parallel columns.

<i>Respondent's Statement</i>	<i>Comment</i>
1. "It has always been assumed, as petitioners acknowledge, that an invention is unpatentable if the identical invention, achieved at a prior time by another inventor, is claimed in a copending patent application. This result follows <i>not from any special rule</i> as to copending patents, but from the basic and guiding principle that priority is determinative. * * * (p. 10; emphasis added)"	In fact there is a "special rule" applying to copending patents—namely Section 102(e) of the Patent Act. However, Petitioners agree that the "guiding principle (of) priority is determinative". That is why the Wallace et al. patent is not a bar to the grant of a patent on the Regis application for the Patent Office never contended that Wallace et al. were prior inventors of the Regis invention.

*Respondent's Statement**Comment*

2. "• • • *Milburn* means that, 'for the purpose of anticipating a subsequent inventor,' a United States patent disclosing an invention dates from the date of filing the application.' Under this standard, the *Regis* invention in this case was unpatentable, since it disclosed no patentable, advance over *Wallace*, which had been previously filed in the Patent Office." (p. 13)

3. "Indisputably, the copending patents referred to in *Detrola* were of the type involved in the instant case, i.e., patents not identical with the subsequent invention, but in light of which that invention would have been obvious to one skilled in the art within the doctrine of *Hotchkiss v. Greenwood*, *supra*, and Section 103 of the Act. • • •" (p. 15)

4. "• • • Indeed, P. J. Federico, Examiner-in-Chief of the Patent Office and an active participant in the 1952 revision, could not have made this clearer when he stated, with regard to this question, that '[t]he antecedent of the words "the prior art" • • • lies in the phrase "disclosed or described as set forth in Section 102" and hence these words refer to material specified in Section 102 as the basis for comparison.' (*Commentary on the New Patent Act*, • • • emphasis added.) • • •" (p. 24)

The last sentence is untrue. The Patent Office never contended that the *Regis* invention "disclosed no patentable advance over *Wallace et al.*" and it is not a fact. It held only that if to the invention of *Wallace et al.* were added the invention of *Carlson*, then, and only then, would the combination anticipate the *Regis* invention.

As previously pointed out (BP, pp. 17-19), each of the reference patents relied on by defendant in the *Detrola* case was held individually to show that *Wheeler* was not the first inventor. The doctrine of *Hotchkiss v. Greenwood* was not involved and was not referred to by this Court in the *Detrola* decision.

This reference to a definition of the term "prior art" in Section 103 is merely one unofficial commentator's view. Moreover, this commentator, immediately following the quoted sentence, quotes with tacit approval the portion of the same Committee Report which is relied upon by Petitioners (BP, p. 8). As there pointed out, the Committee Report defines the term "prior art" as meaning what "was known before as described in Section 102" that is, in Section 102(a), which is the only subsection referring to what "was known • • • before".

## Respondent's Statement

## Comment

5. "This precise situation confronted the Court in *Milburn*. There, *as here*, a copending application, the existence of which the later applicant could not have known, disclosed the subject matter of the subsequent application. \* \* \*" (p. 28; emphasis added)

6. " \* \* \* Petitioners' suggestion (Pet. Br., p. 24) that 'unfairness' in the *Milburn* case was overbalanced by the need to reward the prior of two rival inventors, is not borne out. In *Milburn*, the prior copending patentee did not claim the invention claimed in the subsequent application, and the two inventors were not rivals. \* \* \*" (p. 29)

7. "Petitioners, on the other hand, ignore the unjustifiable burdens upon the public and the prior inventor that would potentially be caused by the issuance of two or more overlapping patents which except for *non-patentable variations*, would cover the same subject matter. If both the Wallace and Regis patents were to issue, for example, a member of the public wishing to use *the single patent*-

This statement is but a reiteration of Respondent's contention that the Wallace et al. copending patent "disclosed the subject matter of the subsequent application" of Regis. The Patent Office never so contended (*supra*, pp. 6-7) and it is not a fact.

This is a serious distortion of Petitioners' position as stated in their Brief:

" \* \* \* There, but for the rule, a patent could issue to one who actually made an invention *after* the inventor of the copending patent, who could then take away the right of the earlier inventor to practice his own invention, a common law right arising from the creative act of invention. \* \* \*" (p. 24; emphasis in original)

Petitioners' position includes no question of any *reward* to a prior inventor.

At this point, Respondent merely rings the changes on its unfounded and untrue assertion that the Regis and Wallace et al. disclosures are for a "single patentable innovation". The Patent Office never so contended and it is not a fact (*supra*, pp. 6-7). If the Regis patent were granted, neither the public nor Wallace et al. would require a license thereunder to utilize the invention of the Wallace et al.

*Respondent's Statement**Comment*

able innovation embodied in both might have to obtain licenses from both patentees, and Wallace, the prior inventor, might have to obtain a license from Regis in order to make use of Regis' non-patentable variation. In addition, the Regis patent would improperly extend the monopoly on the basic invention vis-a-vis the general public beyond the statutory period previously awarded to Wallace.  
 • • •" (p. 29; emphasis added)

patent. Moreover, the Regis patent, being for an invention admittedly not disclosed by Wallace et al., would not extend the monopoly of that patent vis-a-vis the general public.

## V. CONCLUSION

In conclusion, it is submitted that nothing in Respondent's Brief is an adequate basis for refusal of the relief sought by Petitioners and that such relief should be granted.

Respectfully,

LAURENCE B. DODDS

59-25 Little Neck Parkway  
 Little Neck, New York 11362  
*Attorney for Petitioners.*

Of Counsel:

GEORGE R. JONES

425 Thirteenth Street, N.W.  
 Washington, D. C. 20004

## APPENDIX

This Appendix is an analysis of authorities erroneously cited by Respondent in support of its position that a co-pending patent is competent evidence of the "prior art" as of its filing date:

*Industrial Wire Cloth v. United Specialities* (C.A. 6, 1951) 186 F.2d 426. This case involved three patents of one Zander filed on February 25, 1932, April 12, 1933, and February 19, 1934, respectively. The three patents were held invalid over a group of prior art patents, that is, patents *issued before* the filing dates of any of the Zander patents. Defendant also urged as anticipation of all of the three patents, copending patents to Hinkle, issued March 29, 1932, and Garner, issued February 14, 1933. In rejecting this defense, the Court said:

"While we do not agree with the district court that a prior but co-pending application belongs in the prior art, *Toledo Plate & Window Glass Co. v. Kawneer Mfg. Co.*, 237 F. 364 (C.C.6), when the issues do not involve priority of conception and putting into practice, we do agree that Zander's second and third patents are invalid. \* \* \*" (p. 429-430) [That is, the Zander patents filed April 12, 1933, and February 19, 1934, *after* the issuance of the Hinkle and Garner patents which were *not* copending with these two later Zander patents.]

*Permo v. Hudson-Ross* (C.A. 7, 1950) 179 F.2d 386. The Semple patent in suit was filed January 28, 1942. Defendant alleged that it was invalid over five patents, all copending with the application for the Semple patent, which defendant urged constituted "prior art." In rejecting this defense, the Court said:

"But it is not necessary for us here to determine whether the co-pending applications of the patents hereinbefore described should be considered as prior

art in the technical sense, for it is a widely recognized rule that even though such co-pending application which ripens into a patent may not be a part of the prior art in its usual sense, the application for such patent can nevertheless be used to prove that the patentee of the patent in suit was not the original and first inventor or discoverer of any material or substantial part of the thing patented. (Citing cases) \* \* \* (p. 389)

The Court then went on to affirm the decision of the District Court to the effect that each of the patents cited by defendant individually and independently showed:

“\* \* \* Semple was not the original or first inventor or first discoverer of any material or substantial part of the thing patented \* \* \*.” (p. 390)

*Conmar v. Universal Slide* (C.A. 2, 1949) 172 F.2d 150. This action involved two patents on slide fasteners (zip-pers), one to Wintritz and one to Ulrich. As to the Wintritz patent, the Court held that a copending patent to Poux showed that Wintritz was not the first inventor, saying:

“It is true that Poux was not a part of the prior art when Wintritz filed his application; but he was a prior inventor, and the validity of Wintritz’s invention depends upon the same considerations as though Poux had been in the prior art; i.e., whether the steps he took beyond Poux, — his variations upon Poux’s theme, — were of themselves an invention. \* \* \* (p. 152)

\* \* \*

“\* \* \* taken merely as a conception, Poux was the prior inventor, for Poux’s disclosure was for a process in two separate steps. A competent workman in the field who wished to follow Poux would have found the means at hand in Sundback’s machine. These claims are also invalid.” (p. 153)



### A-3

The essence of the last-quoted excerpt is that Wintritz and Poux described essentially the same invention—any difference in the Wintritz disclosure over the Poux disclosure was an insignificant one as to which any “competent workman in the field \* \* \* would have found the means at hand \* \* \*.” The Court then held the Ulrich patent invalid upon either of two prior art patents which were *not* copending.

*In re Youker* (CCPA, 1935) 77 F.2d 624. In this case, the Patent Office had rejected the application in issue on three copending patents. The decision of the Court is ambiguous. It includes a correct statement of the law:

“It appears that the patents to Seguy, Howard et al. and Dickson were not issued until after appellant had filed his application. Therefore, they are not technically a part of the prior art, \* \* \* they show prior invention of their subject-matter and we must assume that appellant may not properly be held to be the first inventor of anything disclosed by them or of anything not patentably distinct from them. *In re Smith*, 17 C.C.P.A. (Patents) 752, 36 F.(2d) 522.” (p. 624)

Moreover, the opinion includes a further statement seeming to hold that *each* of the cited reference patents individually and independently showed that Youker was not the first inventor and thus, to apply the rule previously stated:

“In view of the concessions of appellant, it is not deemed necessary to recite in detail the disclosures of each reference. His brief concedes that his steps 1, 2, and 3, as above set forth, are taught by at least three of the references, viz., Seguy, Howard et al. and Shevlin.” (p. 625)

Later in the opinion, nevertheless, the Court did express approval of a holding of the Patent Office that it would

have been obvious to modify the structure of one of the copending patents in view of the teaching of another, which necessarily requires a consideration of them as a part of the prior art. This portion of the opinion appears to be inconsistent with the correct principle previously set forth in the opinion.

*Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379. This action involved a Lewis et al. patent on a "hectograph" copy sheet. Judge Hand held the patent claims in issue invalid because a copending patent to one Foster showed that he was the prior inventor. In so doing, the Court said:

"\* \* \* we hold that Foster's patent No. 2,060,190, issued on November 10, 1936, upon an application filed January 10, 1935, is a 'prior invention' to the patent in suit, \* \* \*. (p. 380)

"Foster filed his application over twenty months before Lewis and Menihan filed theirs, but his patent did not issue until after they had filed, and his disclosure was therefore not prior art; if it is to invalidate their claims it must be because he was the 'prior inventor.' \* \* \*" (p. 381)

Judge Hand continued by analyzing the decision of this Court in the *Alexander Milburn* case, *supra*, pointing out that one must look to the *disclosure* of a copending patent, not to its claims, to determine whether the patentee was a prior inventor, drawing an analogy to the disclosure in a prior publication or prior public use, neither of which, of course, includes any patent claims at all. It is in *this* light that Judge Hand continued with the statement quoted in Respondent's Brief (p. 19):

"\* \* \* Accordingly we are to treat the disclosure in Foster's specifications of the past practice of using double sheets to prepare a 'master sheet' for use in Ritzerfeld's machine precisely as though it had ap-

peared in a printed publication before Lewis and Menihan had filed their application. The validity of the claims in suit therefore depends upon whether they can survive this disclosure, \* \* \*." (p. 382)

In the context of Judge Hand's preceding discussion, it is clear that in the last-quoted statement he was adverting *merely* to the fact that in considering the anticipatory effect of a copending patent, the claims of that patent are to be disregarded. There is nothing in Judge Hand's decision which suggests that a copending patent is competent as of its filing date, to show anything other than that a later applicant for the same invention was not the first inventor.

*Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345. This case involved four patents relating to centrifuge mechanisms. The first patent, No. 1,758,901 to Roberts, filed May 13, 1930, the Court termed the "control patent." Defendant urged as an anticipation of that patent a patent to Carlson 1,669,927, granted May 18, 1928, virtually two years *before* the filing date of the Roberts patent and therefore *not* a copending patent at all. While the opinion includes an extended philosophical discussion of the rationale of the decision of this Court in *Alexander Milburn, supra*, the final holding of the Court was that the patent was valid but not infringed.

While Petitioners listed this *Western States* decision as one holding *contra* to its position (BP, A-5), actually the language so stating is pure dictum since the patent was held to be valid. Consequently, the dictum in the *Western States* opinion must give way to a clear and correct statement and application of the law by the same Court and the same Judge in the *Old Town Ribbon* case decided approximately two years later.